

REMARKS

Upon entry of the amendments presented, Claims 1-2 and 3-10 are pending in the application. No additional claims fee is due as a result of these amendments.

Invention Synopsis

The present invention as now amended is directed to a transparent skin care composition comprising (a) a surfactant combination; (b) an oily compound; (c) a polyhydric alcohol; and (d) water; wherein the oil compound is substantially solubilized in the transparent skin care composition. The combination of surfactants in the specified ratios can emulsify various types of oils, providing pleasant skin feel, and moisturization of the skin without greasy feel. In addition, these stabilized compositions have longer shelf life.

Formal Matters

The applicants would like to first point out that the office action, dated November 9, 2001, was unsigned by the examiner and her supervisory examiner. In a telephone conversation with the examiner on or about March 6, 2002, the applicants requested a signature copy of the action. In response a facimile copy was received by the applicants on March 11, 2002.

The examiner objected to the specification on the basis the applicants have improperly used the terms comprising and the term consisting of in the specification as transitional phrases as described in MPEP § 2111.03. This also serves as the basis of the rejection of claims 1-10 under 35 USC §112, second paragraph as being indefinite for failing to particularly point out and distinctively claim the subject matter that the applicant regards as the invention. The applicants traverse this rejection.

The applicants use of the term "consisting of" in element (a) of claim one as is traditionally recognized as claiming alternative chemical entities without presenting any uncertainty or ambiguity with respect to the scope or the clarity of the claims. Such is described in MPEP 2173.05(h), "Alternative Limitations" in the context of Markush Group language. Use of the phrase "selected from the group consisting of..." is acceptable and examples are found throughout the chemical patent collection using the same language. As such, the applicants request the examiner to immediately withdraw the objection to the specification and the above rejection of the claims.

Claims 1-10 are also rejected under 35 USC §112, second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter of the invention by using the term "substantially" in claim 1 to describe the point at which the oil compound is solubilized sufficiently in the composition. Applicants would like to point to MPEP §2173.05(b), "Relative Terminology" wherein "substantially" is discussed in subsection D. It's stated therein that where this term is used in conjunction with another term to describe a particular characteristic of the claimed invention, it is acceptable. In the pending claims, "substantially solubilized" is a term used to

describe the solubility of the oil element wherein its use does not negatively impact the composition's physical character; i.e. that it's transparent. Such term, therefore, is clear and acceptable to use in the pending claims.

The examiner also alleges that the applicants' use of the term "ratio" in claims 2-5 as being vague because it is not clear whether the measurement is in weight or volume. Similarly, claim 8 is alleged to be indefinite since the percentages are not designated as weight, volume or moles. The examiner is directed to the specification at page 2, lines 26-28 wherein the applicants state the ratios and percentages are representative of the entire composition. As such, it is inconsequential whether the ratios and percentages are by weight, volume or otherwise.

The examiner rejects claim 4 as it recites surfactants that are not literally found in claim two from which it depends. The applicants points out that claim two is dependent from claim 1 wherein the surfactants mentioned in claim 4 are found. This being the case, recitation of those surfactants in claim 4 have proper antecedent basis; see MPEP § 706.039(d).

The Rejections on the Merits

Claims 1-10 are rejected under 35 U.S.C. §103(a) as unpatentable over Sumida (JP448925, translation).

The examiner alleges that the disclosure in the Sumida makes obvious the pending claims. Sumida discloses using nonionic surfactants including polyoxyethylene (POE) sorbitan fatty acid esters to make micro-emulsions of limited particle sizes from 10 to 200 nm. The method of making the compositions of the pending claims is disclosed starting at line 18 of page 19 of the specification. This method does not involve using a reactor as noted by Sumida at page one to produce a micro-emulsion. Since the pending claims are not specific to micro-emulsions, one skilled in the art would not necessarily apply Sumida's teaching to the compositions disclosed in the amended claims.

Even for argument sake, if one was to apply the teaching of Sumida, it should be recognized that Sumida does not teach or imply using the POE tetraalkyl esters of the presently claimed composition. Sumida teaches mono, tri and penta alkyl esters including POE monooleates, monostearates, trioleates and pentaoleates, however, not tetra alkyl esters. One skilled in the art, noticing the conspicuous avoidance of tetra alkyl esters would actually be taught away from applying them to the presently claimed compositions.

On the basis of the amendment above and the absence of a teaching by Sumida to establish a prima facie case, it is respectfully requested that the current obviousness rejection be withdrawn.

Claims 1-10 are rejected under 35 U.S.C. §103(a) as unpatentable over Koyanagi (sic) et al. (U.S. Pat. No. 5,474,776).

The Examiner contends that it would have been obvious to and thereby arrive at the Applicants' invention in light of Koyanagi et al. Applicants respectfully traverse this rejection.

*new
limit*
*not
comparable
w/ §103C*
Koyanagi discloses transparent cleansing compositions that contain hydrophilic, nonionic surfactants, an amphoteric surfactant, a water-soluble compound containing at least one hydroxy group, a liquid oil and water. Among the numerous hydrophilic, nonionic surfactants disclosed by Koyanagi starting at column 2, line 55 through column 3, line 47 are polyoxyethylene (30) sorbitol tetraoleate and polyoxyethylene (40) sorbitol tetraoleate. There isn't, however, any specific disclosure regarding these tetra alkyl esters with any other specific class of surfactants such as those found in the pending claims, especially not within the presently claimed ratios. To suggest that among all the non-ionic surfactants disclosed by Koyanagi, an artisan is specifically taught the presently claimed combination (at the specified ratio) is highly speculative and unsubstantiated by the teaching found within Koyanagi. This is particularly true since the compositions disclosed by Koyanagi are cleansing compositions, designed to be easily removed from the skin by rinsing with water; see column 1, 45-50, column 2, line 51-54, column 9, lines 42-45, column 10 lines 24-27 and column 10, lines 56-58. The presently claimed compositions remain on the skin to provide moisturizing benefits.

On the basis of the amendment above and the absence of sufficient teaching by Koyanagi by itself or combined with Sumida above to support a prima facie case, it is respectfully requested that the current obviousness rejection be withdrawn.

CONCLUSION

Applicants have made an earnest effort to place their application in proper form and to distinguish their invention from the applied prior art. WHEREFORE, Applicants respectfully request the reconsideration of this application, entry of the amendments presented, withdrawal of the rejections under 35 U.S.C. §112 and §103 and allowance of Claims 1-2 and 4-10.

Respectfully submitted,

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MARKED VERSION SHOWING CHANGES MADE**IN THE CLAIMS**

1. A transparent skin care composition comprising:

- (a) two or more surfactants including a first surfactant being polyoxyethylene sorbit tetraalkyl ester and a second surfactant selected from the group consisting of [polyoxyethylene sorbit tetraalkyl ester,] polyoxyethylene castor oil[,]; [and/or] polyoxyethylene hydrogenated castor oil ester[,]; polyoxyethylene alkyl phosphate and [or] its salts[,]; and mixtures thereof;
- (b) an oil compound;
- (c) a polyhydric alcohol; and
- (d) water;

wherein the oil compound is substantially solubilized in the transparent skin care composition and the ratio of said first surfactant to said second surfactant is from about 4 : 1 to about 2 : 3.